

## REMARKS

Claims 11-17 and 19-22 are currently under consideration, claims 1-10 and 18 having been canceled previously. By means of the present amendment, claims have been amended as above.

### Rejections under 35 U.S.C. § 112

Applicants respectfully traverse and, for the following reasons, request reconsideration and withdrawal of the rejection of claims 11-17 and 19-22 under 35 U.S.C. §112, ¶1 as failing to comply with the written description requirement (i.e., a possession rejection).

The written description requirement for a claimed genus may be satisfied through sufficient description of a representative number of species by actual reduction to practice and/or by disclosure of relevant, identifying characteristics, i.e., structure or other physical and/or chemical properties, by functional characteristics coupled with a known or disclosed correlation between function and structure, or by a combination of such identifying characteristics, sufficient to show the applicant was in possession of the claimed genus. MPEP 2163(II)(A)(3)(a).

The test for sufficiency of support in a parent application is whether the disclosure of the application relied upon "reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter." *Ralston Purina Co. v. Far-Mar-Co., Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985) (quoting *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983)). The test for sufficiency of support in a parent application is whether the disclosure of the application relied upon "reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter." *Ralston Purina Co. v. Far-Mar-Co., Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985) (quoting *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983)). The test is not whether the literal words of each claim limitation are used in the specification. MPEP 2163.02.

Examiner claims that "...on top of each other up to three or more layers" is not supported in the specification. Applicant strongly disagrees and directs Examiner to, for example, paragraph 0022 of the instant specification. Although a specific number of layers is not discussed Applicant believes layering is strongly supported in the specification, and the number "three" is sufficiently clear to give any infringer notice of what is claimed. Applicant requests withdrawal of this rejection.

Examiner states that "metal incapable of alloying with lithium" is not supported in the specification even though the specification states "metal not alloyed with lithium." Applicant disagrees, but, in order to hasten allowance, Applicant has modified claims to reflect such. Applicant does not believe this requires a further search on the part of the Examiner and requests prompt allowance. Applicant further believes that taken in context "not" can mean, and thus there is support for, "incapable of alloying".

Claim 21 has been rejected as "z" is undefined, according to the Office. "z" has been added to correct an obvious typographical error.

Claim 12 states "said thin film layer" and this has been modified to "said film layer" to correct an obvious typographical error.

Claim 14 recites "thin film" in two places. Applicant has modified to "film" to correct an obvious typographical error.

Claim 16 contains the same typographical error which is herein repaired.

#### **Rejections under 35 U.S.C. § 102**

Claims 11-18 and 21 were rejected under 35 USC § 102(b) as being anticipated by WO/2001/084654 using US Publication 2003/0108795 (Tamura) as the English translation. Applicants respectfully traverse and, for the following reasons, request reconsideration and withdrawal of this rejection.

To establish anticipation of the claimed invention, a reference must disclose the invention as set forth in the claim, i.e. a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Applicants respectfully submit that Tamura does not anticipate Applicants' claimed invention as set forth in the claims as presently amended because the cited reference fails to disclose each and every

limitation of the claims at issue as presently amended. In particular, Tamura does neither disclose nor reasonably suggest an anode substrate which comprises a polymer substrate, and the rejection should be withdrawn. Examiner argues that a substrate is somehow a product-by-process limitation. This is untrue.

A product-by-process limitation is:

"The structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art, especially where the product can only be defined by the process steps by which the product is made, or where the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product. See, e.g., *In re Gerner*, 412 F.2d 276, 279, 162 USPQ 221, 223 (CCPA 1979) (holding "interbonded by interfusion" to limit structure of the claimed composite and noting that terms such as "welded," "intermixed," "ground in place," "press fitted," and "etched" are capable of construction as structural limitations.)" MPEP 2113

Herein the limitation to a substrate is clearly to a product, no method (process) steps are present in the claim at issue at any point. A substrate is a substratum or supporting material. Applicant encourages Examiner to look at any dictionary definition, as Applicant believes Examiner will determine this is not a product by process limitation. Applicant respectfully requests the Office reevaluate it's position with respect to product-by-process and withdraw this rejection.

#### **Rejections under 35 U.S.C. § 103**

Claims 19-20 were rejected under 35 U.S.C. 103(a) as being unpatentable over Tamura in view of 6,051,340 (Kawakami). Applicants submit that the rejection is improper because Hagg is nonanalogous art to the subject matter of the claims as presently amended. The structural and functional differences between the cited reference and the subject matter of the claimed invention are such that it cannot be relied upon as a basis of a rejection, thus rendering the rejection improper.

The claimed invention relates to a non-aqueous electrolyte battery comprising an anode which comprises, inter alia, a polymer-comprising anode substrate and thin

film layers disposed on said anode substrate. Such thin film layers contain, inter alia, a metal incapable of alloying with lithium, and a metal element or compound capable of alloying with lithium and serving as an anode active material.

Hagg discloses electrodes, in particular bipolar composite electrodes characterized by an electrochemically active layer bonded to a substrate material (See page 1, lines 1-10). Bipolar electrodes act as an anode on one side and a cathode on the other side, and the substrate material provides a conductive pathway between the facing layers of electrochemically active fibrous material such as graphite felt or carbon felt (See page 1, lines 26-37). In the electrode of Hagg, the substrate is a non-conductive material such as a polymeric material (See page 5, lines 30-35; page 6, lines 24-31).

As the substrate is non-conductive, the conductive pathway is provided as follows: each of the surfaces of the substrate carries a layer of fibrous electrochemically active material, wherein the fibers of both the opposing layers of electrochemically active material penetrate the electrode substrate material. The contact between the penetrating fibers of each layer provides a current transfer pathway between the layers through the substrate material (See page 10, lines 38-44; Figure 5).

In the battery of the claims as presently amended, a current transfer pathway between the two faces of the substrate is neither needed nor particularly desirable. Moreover, the present invention comprises film metal layers deposited on the substrate, not fibers penetrating the substrate. Accordingly, the teachings of Hagg are directed to the creation of a structure differing from that of the claimed invention in structure, function and materials. The rejection is therefore based on a nonanalogous reference, and should be removed.

Claims 16-17 were rejected under 35 U.S.C. 103(a) as being unpatentable over Tamura in view of 6,051,340 (Kawakami).

To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations; there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; and there must be a reasonable expectation of success. MPEP § 2143.

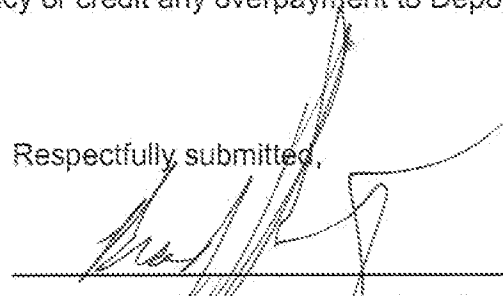
Further the Federal Circuit has recently held that most inventions arise from a combination of old elements and each element may often be found in the prior art. However, mere identification in the prior art of each element is insufficient to defeat the patentability of the combined subject matter as a whole. *In re Kahn* 441 F.3d 977 (Fed. Cir 2006). In the instant case the Examiner has randomly searched the patent literature and combined references for which there would have been no motivation to combine until the instant invention. A simple citation to the presence of each element in the prior art does not suffice.

**Conclusion**

Applicant traverses all rejections and, in view of the foregoing, it is submitted that all the claims are allowable and that the application is in condition for allowance. Notice to that effect is respectfully requested. The Commissioner is hereby authorized to deduct any deficiency or credit any overpayment to Deposit Account No. 19-3140

Respectfully submitted,

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